

REMARKS

I. Status of the Claims

Claims 1, 7-27, 33-60, 66-89, 95-117, and 119-122 are presently pending in the application. Without prejudice or disclaimer, claims 19, 45 and 107 are cancelled. Without prejudice or disclaimer, claims 1, 18, 27, 44, 60, 77, 89, 106, and 115-117 are amended. Exemplary support for the amendment can be found in the specification as-filed. *See e.g.* Specification as-filed at [0033]. Accordingly, there is no written description issue raised by this amendment.

II. Rejection Under 35 U.S.C. § 112, ¶ 1

The Examiner maintains the rejection of claims 1, 7, 20, 27, 33, 46, 60, 66, 79, 89, 95, 108, and 115-117 under 35 U.S.C. § 112, first paragraph for allegedly "failing to comply with the written description requirement." Office Action at 2. Specifically, the Examiner asserts that the ranges of (1) 5 to 60% of the high viscosity phenyl siloxane oil; (2) 5 to 60% of the non-volatile ester oil; and (3) 5 to 80% of the low viscosity phenylsiloxane oil are not supported by the specification. *See id.* at 2-3. Regarding the high viscosity phenyl siloxane oil, the Examiner states that he "could not find written support for this new limitation." *Id.* at 2. The Examiner notes that paragraphs [0047] and [0067] of the specification as-published (U.S. Patent Application Publication No. 2004/0126350 A1) only provide support for 10 to 60% of both the high viscosity phenyl siloxane oil and the non-volatile ester oil, and paragraph [0048] only provides support for 7.5 to 80% of the low viscosity phenylsiloxane oil. *See id.* at 2-3. The Examiner

further alleges that "[a]pplicants apply the value of 5 as their lower range when this value was clearly only contemplated for their broader recited range of 5 to 99%. Thus applicants are essentially picking and choosing the end points for their range when clearly those endpoints were concerned with two entirely different ranges." *Id.* at 4. Applicants respectfully disagree and traverse for the reasons of record and for the reasons below.

The present specification teaches that:

The high-viscosity phenylsilicone oil may be present in the composition in an amount ranging from 5 to 99% of the total weight of the composition, for example from 7.5 to 80%, and further, for example, from 10 to 60%, and still further, for example, from 20 to 50%.

The low-viscosity phenylsilicone oil (if present) may be present in the composition in an amount ranging from 5 to 99% of the total weight of the composition, for instance from 7.5 to 80%, for example from 10 to 60% and for example from 10 to 40%.

....

The non-volatile hydrocarbon oil may be present in the composition in an amount ranging from 5 to 99%, for example from 10 to 60%, and for example from 15 to 50%, relative to the total weight of the composition.

Specification as-published at ¶¶ [0047], [0048], and [0067] (emphasis added). Thus, Applicants expressly contemplated that the ranges of the high-viscosity phenylsilicone oil, low-viscosity phenylsilicone oil, and non-volatile hydrocarbon oil may vary within the wide range disclosed. The narrower ranges listed in the specification state that they are merely examples, and not fixed.

"[S]ubject matter of the claim need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description

requirement." M.P.E.P. § 2163.02. "With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure." M.P.E.P. § 2163.05 III (emphasis added); (citing *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) (holding that a limitation to "between 35% and 60%" did meet the description requirement, when the original specification included a range of "25%-60%" and exemplary points at 36% and 50%)). The 5% to 99% range encompasses, and therefore inherently supports the narrower sub ranges. Moreover, the broad disclosure of from 5% to 99%, along with the explicitly recited narrower disclosures of the exemplary ranges within said broad disclosure, allows for the claimed sub-ranges to meet the written description requirement. The original range coupled with the example ranges, allow one skilled in the art to envision the now recited claims.

For these reasons, Applicants respectfully submit that the specification as-filed provides written description support for the claimed ranges for each of the aforementioned components and the rejection should be withdrawn.

III. Rejection Under 35 U.S.C. § 103(a)

A. **Arnaud**

The Examiner maintains the rejection of claims 1, 7-27, 33-60, 66-89, 95-117 and 119-122 under 35 U.S.C. § 103(a) as allegedly being "unpatentable over Arnaud" for the reasons of record. Office Action at 4. Specifically, the Examiner reasons that "[s]imply because Arnaud discloses more than one type of phenylsiloxane oil does not mean that the high viscosity phenylsiloxane oils are not disclosed, in fact several of the

phenylsiloxane oils are the same oils that applicants list in their specification as having the desired high viscosity such as PCR 15M30." *Id.* at 5. The Examiner further notes that Arnaud "clearly discloses that advantageously more than one type of oil is used and the secondary oil includes synthetic esters such as diisostearyl malate." *Id.* Finally, the Examiner asserts that "the same phenylsiloxane oil and ester oil tridecyl trimellitate are claimed in mixtures or combinations thereof, thus the two oils are within the claimed subject matter of the patent." *Id.* Applicants disagree and traverse the rejection for the reasons of record and for the following additional reasons.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) secondary considerations. 148 U.S.P.Q. at 467. "Such evidence . . . may include evidence of . . . unexpected results." M.P.E.P. § 2141. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. See *Graham*, 148 U.S.P.Q. 467; see also *KSR*, 82 U.S.P.Q. 2d at 1388.

In further support of the arguments on record, Applicants submit herewith the Declaration under 37 C.F.R. §1.132 of Véronique FERRARI ("Declaration"). Submission of the Declaration in no way indicates that Applicants concede that the

Examiner has established a *prima facie* case of obviousness. Instead, the Declaration clearly shows the unexpected results attributable to the claimed composition reciting specific non-volatile ester oils. By its very nature, an obviousness rejection is based on the Examiner's assumption that similar compositions will exhibit similar properties. However, the Declaration merely demonstrates that such an assumption is incorrect with respect to the compositions of the present claims.

In the Declaration, two series of comparative tests are performed. In the first series of comparative tests, the inventive compositions contain non volatile ester oils having a molecular mass of more than 500g/mol chosen from those recited in claim 1, whereas the comparative composition contains isononyl isononanoate. See Declaration at ¶¶ 6-9, Table 1.

The comparative tests show that sticks of compositions 1-4 are deposited well and that the resulting film of composition was homogeneous and glossy, whereas the stick of comparative composition 5 was judged to have poor deposition properties owing to an excessively soft consistency. See Declaration at ¶¶ 15-18, Tables 2-3, Photo 1. The quantitative differences in hardness are statistically significant. In addition, the qualitative differences presented in Table 3 in the Declaration are at least of the type used on a regular basis by L'Oréal to draw distinctions between different compositions.

Applicants have demonstrated that the claimed combination of at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and at least one non-volatile ester oil having a molecular mass of more than 500g/mol chosen from pentaerythrityl tetrapelargonate,

diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate results in certain benefits as compared with comparative compositions containing a high viscosity phenylsilicone oil and a non-volatile ester oil not claimed. These results are unexpected in view of Arnaud, and show unpredictability in the art. See Declaration at ¶¶ 19.

In the second series of tests, the two inventive compositions, compositions 4 and 6 were prepared with di-isostearyl malate as the at least one non-volatile ester oil having a molecular mass of more than 500g/mol. See Declaration at ¶¶ 20-23, Table 4. Furthermore, composition 6 contained a different high viscosity phenylsilicone oil, also according to the invention, phenyl trimethylsiloxy siloxane(silcare silicone 15M30 phenyl trimethicone (viscosity 500 cSt). See *id.* Comparative composition 7, was also prepared with phenyl trimethylsiloxy siloxane(silcare silicone 15M30 phenyl trimethicone (viscosity 500 cSt), but with isononyl isononanoate instead of any of the claimed non-volatile ester oil having a molecular mass of more than 500g/mol. See *id.*

As in the first series, the inventive compositions, 4 and 6, are deposited well and the resulting film of composition was homogeneous and glossy, whereas the stick of comparative composition 7 was judged to have poor deposition properties owing to an excessively soft consistency. See Declaration at ¶¶ 30-33, Tables 5-6, Photo 2. These results are unexpected in view of Arnaud, and show unpredictability in the art. See Declaration at ¶ 34.

Thus, the Examiner has not established a *prima facie* case of obviousness in light of the unpredictability shown by the data in the Declaration. Accordingly, this rejection should be withdrawn.

B. Arnaud in view of Willemin

The Examiner maintains the rejection of claims 1, 7-27, 33-60, 66-89, 95-117, and 119-122 under 35 U.S.C. § 103(a) as allegedly being "unpatentable over Arnaud" in view of U.S. Patent No. 6,592,855 to Willemin et al. ("Willemin") for the reasons of record. Office Action at 4. Specifically, the Examiner notes again "that Arnaud does describe some low viscosity phenylsiloxanes such as DC556 and high viscosity phenylsiloxanes such as PCR 15M30," and "Willemin describes low viscosity phenylsiloxanes were useful in cosmetic compositions." *Id.* at 6. The Examiner concludes that "one of ordinary skill in the art could have selected both a high and low viscosity phenylsiloxane oil simply because they were disclosed as being used for the same purpose and the addition would not change the respective functions of the oils within the composition." *Id.* The Examiner further contends that, "[t]he motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose," citing *In re Kerhoven*, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). Office Action at 7. Applicants respectfully traverse for the reasons of record and for the following additional reasons.

Kerkhoven is not applicable to the present case. In *Kerkhoven*, the appealed claims were directed to a process for forming a detergent, comprising forming two aqueous slurries, where one slurry was predominantly an anionic detergent and the

other was primarily a nonionic detergent, independently or simultaneously drying the slurries, and mixing the resulting products. *See Kerkhoven*, 626 F.2d at 847, 205 USPQ at 1070. It was acknowledged that prior art detergents comprised a mixture of anionic fatty acid soaps, anionic detergents, and nonionic detergents. *Kerkhoven*, 626 F.2d at 848, 205 USPQ at 1071. To make the known detergents, all of the ingredients were combined together in one slurry and then spray dried. *Id.* Therefore, the court agreed with the examiner's conclusion that the claims at issue required "no more than the mixing together" of two conventional detergents to make a third detergent composition set forth "prima facie obvious subject matter." *Kerkhoven*, 626 F.2d at 849, 205 USPQ at 1071 (emphasis added).

There are several key differences between the claimed invention and the invention at issue in *Kerkhoven*. First, the end product in *Kerkhoven* was the same as the two combined ingredients: a detergent. In the claimed invention, the claimed elements are combined to create a lipstick. How individual constituents react to form an end product is not akin to *Kerkhoven* and does not support the Examiner's conclusion of obviousness. This position is supported by the fact that the literal combination of Arnaud and Willemin would not give rise to the claimed invention. Thus, the Examiner's application of *Kerkhoven* is inapposite to the present case.

Even assuming for the sake of argument that one skilled in the art would have been motivated to combine the low viscosity phenylsiloxane of Willemin (see Willemin, col. 2, lines 25-51) with the composition of Arnaud, which Applicants do not concede for the reasons of record, Willemin does not cure the deficiencies of Arnaud.

In particular, as discussed above, and as further supported by the Declaration, one skilled in the art would not be able to arrive at the claimed invention from the various disclosures of Arnaud, and one skilled in the art would not have been motivated from reading Arnaud to arrive at the claimed invention by selecting (1) at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, wherein the at least one high viscosity phenylsilicone oil is chosen from the oils of formula (A), and (2) at least one non-volatile ester oil having a molecular mass of more than 500g/mol chosen from pentaerythrityl tetrapelargonate, diisostearyl malate, tridecyl trimellitate, triisocetyl citrate, pentaerythrityl tetraisononanoate, glyceryl triisostearate, glyceryl 2-tridecyl tetradecanoate, and pentaerythrityl tetraisostearate. Willemin does not cure these deficiencies.

Accordingly, for these additional reasons, Applicants respectfully submit that the rejection should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

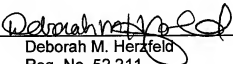
If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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